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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,290	11/03/2003	Takayuki Negami	10873.1338US01	4503
23552	7590	03/21/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			TRAN, MAI HUONG C	
		ART UNIT	PAPER NUMBER	
		2818		

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/700,290	NEGAMI ET AL.	
	Examiner	Art Unit	
	Mai-Huong Tran	2818	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 23 February 2005.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 9-17 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 3-7 is/are rejected.
- 7) Claim(s) 2 and 8 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/22/03.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restriction*

Applicant's election with traverse of Group I (claims 1-8) drawn to a semiconductor device is acknowledged. Accordingly, claims 9-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Because Applicant did not distinctly and specifically point out the supposed error in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Applicant has the right to file a divisional application covering the subject matter of the non-elected claims.

The traversal is on the ground(s) that see the election paper. This is not found persuasive because the fields of search for method' and device claims are NOT coextensive and the determinations of patentability of method and device claims are different, that is process limitations and device limitations are given weight differently in determining the patentability of the claimed inventions. Also, the strategies for doing text searching of the device claims and method claims are different. Thus, separate searches are required.

The requirement is still deemed proper and is therefore made FINAL.

### **Claim Rejections - 35 U.S.C. § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U. S. C. § 102 (b) as being anticipated by U.S. Patent No. 5,236,894 to Tanaka et al.

Regarding to claim 1, Tanaka discloses an electronic device comprising an oxide layer wherein the oxide layer comprises an oxide comprising an element from group IIa, an element from group IIb and an element from group IIIb (page 7, claim 2).

### **Claim Rejections - 35 U.S.C. § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-7 are rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent No. 5,236,894 to Tanaka et al. in view of the remark.

Regarding to claim 3, Tanaka et al. disclose the claimed invention with the oxide layer comprising an element from group IIa, an element from group IIb and an element from group IIIb. However, Tanaka does not disclose the element from group ~~IIa in the oxide~~ is at least one element selected from the group consisting of Be, Mg, Ca, Sr and Ba, the element from group ~~IIb in the oxide~~ is Zn, and the element from group ~~IIIb in the oxide~~ is at least one element selected from the group consisting of B, Al, Ga and In. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select any elements within those groups, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. In re Leshin, 125 USPQ 416.

Regarding to claim 4, Tanaka et al. disclose the claimed invention except for the electronic device wherein a composition ratio of the element from group ~~IIb in the oxide~~ is smaller than a sum of a composition ratio of the element from group ~~IIa~~ and that of the element from group ~~IIb in the oxide~~.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the electronic device wherein a composition ratio of the

element from group ~~IIb in the oxide~~ is smaller than a sum of a composition ratio of the element from group ~~Ia~~ and that of the element from group ~~IIb in the oxide~~, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding to claim 5, Tanaka et al. disclose the claimed invention except for the electronic device wherein a composition ratio of the element from group ~~Ia in the oxide~~ is smaller than that of the element from group ~~IIb in the oxide~~.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the electronic device wherein a composition ratio of the element from group ~~Ia in the oxide~~ is smaller than that of the element from group ~~IIb in the oxide~~.

Regarding to claim 6, Tanaka et al. discloses the claimed invention except for the electronic device wherein the composition ratio of the element from group Ia in the ~~oxide~~ is smaller than that of the element from group ~~IIb in the oxide~~.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the electronic device wherein a composition ratio of the element from group Ia in the ~~oxide~~ is smaller than that of the element from group ~~IIb in the oxide~~.

Regarding to claim 7, Tanaka et al. discloses the claimed invention except for the electronic device wherein the **oxide** further comprises an element from group Vb.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the electronic device wherein the **oxide** further comprises an element from group Vb, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. In re Leshin, 125 USPQ 416.

### **Allowable Subject Matter**

Claims 2 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **Conclusion**

Any inquiry concerning this communication on earlier communications from the examiner should be directed to Mai-Huong Tran, (571) 272-1796. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 6:30 PM. The examiner's supervisor, David Nelms can be reached on (571) 272-1787.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR, Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Mai-Huong Tran